

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Katsunobu HAYASHI

Confirmation No.: 7831

Appl. No.: 09/683,829

Office of Petitions

Cliff Congo, Esq.

Petitions Attorney

Filed : February 20, 2002

For : COMPENSATION CONTRACT SUPPORTING SYSTEM, METHOD FOR  
SUPPORTING COMPENSATION CONTRACT, AND PROGRAM THEREOF

**RENEWED PETITION UNDER 37 C.F.R. §1.181**  
**FOR WITHDRAWAL OF HOLDING OF ABANDONMENT**

Mail Stop: Petition

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

This is a Renewed Petition under 37 C.F.R. §1.181 requesting withdrawal of the Holding of Abandonment of October 8, 2008 in the above-identified application.

In the Decision mailed on November 12, 2008, the Petition under 37 C.F.R. §1.181 requesting withdrawal of the holding of abandonment, which was filed on October 21, 2008, was dismissed. The Decision stated that a request for reconsideration (renewed Petition) must be submitted within two months from the mail date of the Decision, making the request for reconsideration due on January 12, 2009. Therefore, this renewed Petition is timely filed and no fee is required.

The Decision stated the following:

To establish non-receipt of an Office Action, a petitioner:

must state that the Office Action was not received at the corresponding address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office Action was not received. A copy of the record(s) used by the practitioner where the non-received Office Action would have been entered had it been received is required.

In addition, the Manual of Patent Examining Procedure § 711.03(c) also states:

A copy of the practitioner's record(s) required to show non-receipt of the Office Action should include the master docket for the firm. That is, if a three month period for reply was set in the non-received Office Action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the non-received Office Action must be submitted as documentary proof of nonreceipt of the Office Action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log, calendar; reminder system; or the individual docket record for the application in question.

Petitioner has not submitted a copy of the master docket record showing all his replies docketed for a due date of June 18, 2008, nor has petitioner stated that such a record does not exist, in which case petitioner should submit other evidence.

Firstly, Petitioner respectfully refers the Petitions Attorney to the petition filed on October 21, 2008, in which the prosecution history along with relevant docketing information of the instant application is described.

Secondly, Petitioner herein states that the Office Action was not received at the corresponding address of record, and that a search of Petitioner's records, including any file

jacket or the equivalent, and the application contents, indicates that the Office Action was not received. *See Zhang Decl.*, ¶¶ 8-13; *Rios Decl.* ¶¶ 12-14; *Nguyen Statement*, ¶¶ 12-15; and *Hershkovitz Statement*, ¶¶ 12-15.

Further, a copy of the records used by the Petitioner where the non-received Office Action would have been entered had it been received is attached hereto, labeled as Exhibit A and Exhibit B.

Exhibit A is a print-out of the records used by Petitioner, which is a PROLAW system docket specifically for the application at issue (attorney's docket number P13205). If the Office Action at issue had been received, Exhibit A would have shown that for attorney's docket number P13205, an Office Action dated March 18, 2008 was received and would have been entered along with the due dates, with or without extensions of time. As can be seen from Exhibit A, no such indications or entries are shown. Please note that the second entry on this docket, which shows an Office Action date of March 18, 2008, was entered on November 13, 2008, and indicated as such since the docket was updated upon receiving the Notice of Abandonment and obtaining a copy of the Office Action thereafter. After this docket was updated for such, the items in the "Event type" column were automatically updated by the PROLAW system by populating those fields with event types such as "Response to Final Office Action due," "Response to Office Action filed," "Notice of Appeal or Request for Continued Examination," etc. Again, please note that these events were automatically generated after Petitioner updated the docket upon receiving the Notice of

Abandonment and entering the information regarding the Office Action on November 13, 2008, such that there is no date entered in the “Completed Date” column for these events.

Exhibit B is a print-out of the records used by Petitioner, which is a PROLaw docket calendar for the months of March (starting on March 17, 2008), April, May, June, July, August and September (up to September 28, 2008). Please note that this print-out has been redacted to remove confidential information with respect to other cases that do not relate to this case, specifically, having attorney’s docket number P13205. If the Office Action at issue had been received, Exhibit B would have shown that for attorney’s docket number P13205, certain due dates for P13205 would appear and have entries such as “Detailed Analysis of the Office Action,” “Response to Office Action due,” “Reminder sent to Client regarding Office Action,” “Instructions received from Client?,” “Detailed Analysis sent to client?,” etc. As can be seen from Exhibit B, no such indications or entries are shown for P13205.

Exhibit C is a copy of the Yahoo calendar for the week of March 18, 2008. This is the type of Yahoo calendar print-out that was in use in March 2008. The absence of any entries is consistent with an indication that the Office Action of March 18, 2008 was not received, or if it was received, that the Action had been reported to the client (which would have resulted in deletion of that entry). *See Zhang Decl.*, ¶ 11.

Exhibit D is a copy of a print-out of the Yahoo calendar with a query for any entry related to Docket No. P13205. This is the type of Yahoo calendar print-out that would indicate all docketed entries for Docket No. P13205. The absence of an entry related to the

Office Action in question indicates that the Office Action was never docketed in the Yahoo calendar or that a response had already been filed (which would have resulted in deletion of that entry). *See Zhang Decl.*, ¶ 12.

Exhibit E is a copy of the PROLAW report which was attached to the physical file. That report was generated by an employee of the Firm on June 5, 2008 and does not reflect receipt of the Office action dated March 18, 2008. *See Zhang Decl.*, ¶ 15.

Exhibit F is a print-out of a screen capture made on December 8, 2008 from the PROLAW docketing software. That screen shot is based on a search for matter number P13205 and confirms a June 5, 2008 “opened date” for this matter. The screen shot in the middle of Exhibit F shows the “Events Audit Trail” for the 3/18/2008 Office Action. The Audit Trail indicates that the 3/18/2008 event was added on 11/13/2008. *See Zhang Decl.*, ¶ 16.

A Declaration by Ms. Carolina Rios, who is a Legal Assistant and Docket Manager at the firm of Hershkovitz & Associates, LLC, is attached herewith, in support of the facts stated above with respect to the PROLAW docketing system. Also a Declaration by Ms. Jiaxiao Zhang, who was an office manager at the firm of Hershkovitz & Associates, LLC during the relevant time frame, is attached herewith, in support of the facts stated above with respect to the PROLAW docketing system.

Additionally, Petitioner would like to point out the following. Petitioner’s docketing procedure was described in the Petition dated October 21, 2008. In an abundance of caution,

Petitioner would like to elaborate herein in view of the above comments and the Decision. In addition to Petitioner's PROLAW docketing, Petitioner has two other means of ensuring that if an Office Action is received, it is properly docketed and/or responded to.

The first means is by using a YAHOO calendar. When an Office Action is received, the Docket Manager in Petitioner's office would enter in this calendar, the due date for reporting the Office Action to the client (within three days of receipt), the due date for receiving instructions from the client (two weeks from the due date for replying to the Office Action or the due date for replying), and reminder dates to send to the client if instructions have not been received (one month after each prior due date and two weeks before the date of abandonment). For this docketing system, once something is completed, it is deleted from this calendar. If not, the entry for the particular case would be moved to another date. Thus, this calendar changes daily such that submission of a copy of the Petitioner's current YAHOO calendar would not be helpful here. Nevertheless, with the YAHOO calendar, even if information for a particular case is moved (if an event is not completed), or if information for an event is deleted upon completion, a search for P13205 would only yield the entries indicated above. *See Exhibits C and D.*

The second means is by having a designated shelf in the Petitioner's Office for applications where an Office Action has been received and Petitioner is awaiting the client's instructions. Applications that are on this shelf would be checked every month for due dates and reminders in addition to the two docketing systems described above. As can be seen in

Rios Declaration ¶ 8, she did not find the file for the instant application (*i.e.*, Petitioner's file having attorney's docket number P13205), on this shelf.

Separate Declarations by Mr. Dinh Nguyen, who is an attorney at the firm of Hershkovitz & Associates, LLC, and Abraham Hershkovitz, the Head of the Firm, are attached herewith in support of the facts stated above with respect to the PROLAW and YAHOO docketing systems and the second means of having a designated shelf for docketing as described above.

Thus, Exhibit B is a copy of the master docket record showing all of Petitioner's replies docketed for a due date of June 18, 2008. Together, Exhibits A-F and the description above provide the required proof with respect to Petitioner's master docket record, calendar system, reminder system and/or individual docket record. Therefore, it is believed that these exhibits address the requirements stated in the Decision dated November 12, 2008.

Finally, with respect to the docketing manager's duties as described in the attached Declarations and above, the undersigned usually serves as a "second pair of eyes" to work performed by the docket manager and the Legal Assistants.

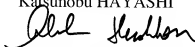
#### CONCLUSION AND REQUEST

It is hereby requested that the holding of abandonment be withdrawn in this case and that the Deciding Official re-start the period for filing a response from the date that Applicant first became aware of the Office Action, which is October 8, 2008.

A fee is not believed to be required by the filing of this Petition. However, if any fees are required for consideration of this Petition, or to reinstate the pendency of the application, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 50-2929 making reference to docket number P13205.

Should the Deciding Official have any questions or comments regarding this matter, the undersigned may be contacted at the below-listed telephone number.

Respectfully submitted,  
Katsunobu HAYASHI



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Abraham HersHKovitz  
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January 5, 2009  
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